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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/660,126 | 09/10/2003 | Hun C. Lee | 003-58 | 6914 |
| 47360 | 7590 | 04/12/2005 | EXAMINER | |
| JAMES E. BRUNTON, ESQ. P. O. BOX 29000 GLENDALE, CA 91209 | | | SUHOL, DMITRY | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3714 | |

DATE MAILED: 04/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/660,126 | LEE ET AL. | |
| | Examiner | Art Unit | |
| | Dmitry Suhol | 3714 | |

– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☒ Claim(s) 6 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claim Objections

Claim 6 is objected to because of the following informalities:

Section (e) of claim 6 states "said plurality of toys", however the toys are not taught until section (f) of the claim therefore sections (e) and (f) should be reversed.

Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 4-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over "Bank of Elmwood" advertisement, hereafter referred to as "Elmwood", in view of LaVanway '578 and Woods '570. Elmwood discloses a banking establishment having a children's window accessible (permitting the child access to the teller window as required by claim 9) by a child "...the child is entitled to use a special teller window just for Woody Savers..." as required by claim 1 and providing a specifically designed savings book (passbook) as required by claims 1 and 9.

LaVanway teaches that it is known for a banking institution to have a plurality of teller windows (col. 1, lines 20-22 and figure 1) in order to service a plurality of customers as quickly as possible.

Woods discloses that it is known to provide a portable bank in the shape of a mall pig, as required by claims 1 and 5, (pig 10) to a child after the child opens an account (see abstract) for the purpose of being able to store money at home if desired. Woods also discloses that it is known to provide a child account holder with a plurality of prizes depending on account criteria (col. 2, lines 62+) as an incentive.

Therefore it would have been obvious to one having ordinary skill in the art, at the time of the claimed invention, to have included a plurality of teller windows in the Elmwood bank for the purpose of servicing all of the customers, especially since the teller window disclosed in Elmwood is only for children having a "Woody Saver" account. It would have been further obvious to have included a portable bank and a plurality of prizes in combination with Elmwood for the purpose of allowing the child customer to store his/her account money at home or at the bank as well as well as to provide incentive in good account management and savings.

Regarding teller window panels and associated indicia provided thereon, as required by claim 4, LaVanway shows that it is known for teller windows to have panels (figure 1). While it would have been obvious to one having ordinary skill in the art at the time of the claimed invention to include illustrations attractive to children on the teller windows since it would only depend on the intended use of the assembly and the desired information to be displayed. Further, it has been held that when the claimed

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printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. *In re Gulack* 217 USPQ 401, (CAFC 1983) and *In re Ngai*, 367 F.3d 1336, 70 USPQ2d 1862. The fact that the content of the printed matter placed on the substrate may render the device more convenient by providing an individual with a specific type of aesthetic display does not alter the functional relationship. Mere support by the substrate for the printed matter is not the kind of functional relationship necessary for patentability. Thus, there is no novel and unobvious functional relationship between the printed matter (e.g. illustrations attractive to children) and the substrate (e.g. teller window panels) which is required for patentability.

Claims 2-3, 6-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over "Elmwood", LaVanway '578 and Woods '570, as stated above, and further in view of Learnard '866. Although Elmwood discloses most of the claimed features, as stated above, the reference fails to explicitly teach providing publications designed to teach banking procedures and establishing a plurality of savings goals and respective awards as required by claims 2, 3, 6 and 9-10.

Learnard discloses that it is known to display brochures and other literature by a bank explaining the banks services (col. 1, lines 19-21). Therefore it would have been obvious to include publications explaining banking procedures and outlining savings goals and rewards for the purpose of providing the customer with desired bank and account information and since it would only depend on the intended use of the

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assembly and the desired information to be displayed. Further, it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. *In re Gulack* 217 USPQ 401, (CAFC 1983) and *In re Ngai*, 367 F.3d 1336, 70 USPQ2d 1862. The fact that the content of the printed matter placed on the substrate may render the device more convenient by providing an individual with a specific type of bank services and account description does not alter the functional relationship. Mere support by the substrate for the printed matter is not the kind of functional relationship necessary for patentability. Thus, there is no novel and unobvious functional relationship between the printed matter (e.g. information describing banking procedures and savings goals versus associated prizes) and the substrate (e.g. brochure or other literature) which is required for patentability.

Regarding claim 9, the steps of allowing a child to view the plurality of prizes and explaining to the child the steps to be followed prior to being awarded the selected prizes would have been obvious since the prior art (Elmwood and Woods) is clearly directed to teaching a child about banking and saving through awarding prizes in association with savings goals and steps of displaying prizes prior to awarding them are notoriously known in the art (bank brochures often display a variety of prizes/gifts for a variety of customer transactions that may be performed such as, a toaster for opening an account).

Regarding claim 11, the step of teaching a child how to use a children's savings book would have been obvious since the prior art (Elmwood and Woods) is clearly

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directed to teaching a child about banking and saving and such teaching steps are notoriously known in the art (e.g. see Milne U.S. Patent 2,927,803 col. 1, lines 68-71 for an example of parents teaching children the use of a child savings book).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dmitry Suhol whose telephone number is 571-272-4430. The examiner can normally be reached on Mon - Friday 9am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jessica Harrison can be reached on 571-272-4449. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Dmitry Suhol
Examiner
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